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|--|-------------|----------------------|---------------------------------|-----------------------------|
| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
| 10/722,406   | 11/28/2003  | Miyuki Tanaka        | 245996US0                       | 7403                        |
| 22850 7590 08/09/2007<br>OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | EXAMINER<br>PENG, KUO LIANG     |                             |
|  |             |                      | ART UNIT<br>1712                | PAPER NUMBER                |
|  |             |                      | NOTIFICATION DATE<br>08/09/2007 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/722,406

Applicant(s)

TANAKA ET AL.

Examiner

Kuo-Liang Peng

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1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/9/07 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-18,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,6-18 and 29 is/are allowed.
- 6) ☒ Claim(s) 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: English traslation of JP 05-279571.

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed July 9, 2007 has been entered. Claims 4-5 and 19-28 are deleted. Claims 1, 10 and 29-30 are amended. Now, Claims 1-3, 6-18 and 29-30 are pending.

2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 030307) is/are removed.

3. Claim rejection(s) under 35 USC 102 and 103 in the previous Office Action (Paper No. 030307) is/are removed.

Sumpter (US 5 331 075) discloses a silicone composition comprising a vinyl organopolysiloxane fluid, a silicon hydride siloxane and a platinum catalyst system. The platinum catalyst system can contain a platinum and **indazole**. The amounts of the platinum and the indazole are described in col. 3, lines 3-17 and

col. 6, lines 39-44. However, Sumpter does not teach or fairly suggest the use of the claimed component D) set forth in Claims 1 and 29. Furthermore, as Applicants pointed out that Sumpter's organic nitrogen compounds such as indazole, etc. are used in the form of a **reaction adducts** of platinum and the organic nitrogen compounds. The reaction adducts function as "platinum catalysts" as a whole. (col. 3, lines 28-34 and Examples) Therefore, the siloxane composition contains the **reaction product** derived from indazole, rather than indazole, per se. Therefore, Sumpter does not teach or fairly suggest the claimed component D) set forth in Claim 30.

Wong (US 4 720 431) discloses a silicone composition comprising A) a hydrido-containing polysiloxane, B) an alkenyl group-containing polysiloxane and an **organic**-platinum catalyst. (col. 1, line 36 to col. 2, line 12) The crosslinking reaction between A) and B) occurs in the chain of component B) (i.e., the chain ends of component B) are blocked by triorganosiloxy group)(col. 2, line 46 to col. 3, line 24) The composition can be used for integrated circuit devices. (col. 1, lines 12-33 and 51-61) The composition does not contain cyclic siloxane fractions of D3 to D10. Wong is silent on the use of the specific component D) set forth in the present invention. Palensky (US 4 511 715) teaches the use of a platinum catalyst system containing a platinum and a nitrogen compound such as **imidazole**. (col. 2,

lines 3-47, col. 6, lines 40-44, col. 8, lines 26-38 and Example 4) However, Wong in view of Palensky does not teach or fairly suggest the use of the claimed component D) set forth in Claim 1. Furthermore, as Applicants pointed out that Palensky's organic nitrogen compounds such as imidazole, etc. are used in the form of a **reaction adducts** of platinum and the organic nitrogen compounds. The reaction adducts function as "platinum catalysts" as a whole. (col. 2, line 50 to col. 3, line 25 and Examples) Therefore, the siloxane composition contains the **reaction product** derived from imidazole, rather than imidazole, per se. Therefore, Wong in view of Palensky does not teach or fairly suggest the claimed component D) set forth in Claims 29 and 30.

4. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

***Claim Rejections - 35 USC § 102***

5. Claim 30 is rejected under 35 U.S.C. 102(b) as being anticipated by JP571 (JP 05-279571).

JP571 discloses a method of preparing a silicone rubber or gel derived from a silicone composition comprising an alkenyl-containing polyorganosiloxane, a

hydrogen-containing polyorganosiloxane, a platinum catalyst and an imidazole.

The composition does not contain low-molecular-weight cyclic siloxane fractions D3 to D10. ([0006]-[0024] and Examples) The amount of the platinum catalyst and that of the **imidazole** are described in [0019] and [0024], respectively. Since JP571's composition reads on the claimed one, the flame retardance thereof should be improved. *In re Best*, 195 USPQ 430 (CCPA 1977).

***Allowable Subject Matter***

6. Claims 1-3, 6-18 and 29 are allowed.

7. The following is an examiner's statement of reasons for allowance:

The present claims are allowable for at least the following reason(s) over the closest reference: Sumpter, Wong, Palensky and JP571.

None of Sumpter, Wong and Palensky, taken alone or in combination, does not teach or fairly suggest the use of the claimed component D), *supra*.

JP571 a silicone composition, *supra*. However, JP571 does not teach or fairly suggest the use of the claimed component D).


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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
August 6, 2007

  
Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712